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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,624	10/20/2003	Gail Anderson	033996-005	8979
21839 7590 01/28/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER CARLOS, ALVIN LEABRES	
			ART UNIT 3714	PAPER NUMBER
			NOTIFICATION DATE 01/28/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/687,624

Applicant(s)

ANDERSON, GAIL

Examiner

Alvin L. Carlos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/20/03, 8/04/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 7, 10-14, 16, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith III 5466158.

Re claim 1, Smith III teaches a method of recording or playing back a recorded educational story (column 1 lines 6-9), comprising providing a first dialogue segment between characters in the story establishing a context for the story being accompanied by sound effects to promote visualization of a story scene by listeners (column 6 lines 44-47), providing a first narration segment articulating an issue being presented in the first dialogue segment (column 7 lines 2-20), providing a second dialogue segment between characters in the story emphasizing the issue being accompanied by sound

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effects to promote visualization of a story scene by listeners (column 7 lines 31-42), providing a second narration segment identifying the issues that have been presented (column 7 lines 57-67 and column 8 lines 1-3), providing a concluding dialogue segment between characters in the story providing resolution of the story being accompanied by sound effects promoting visualization of the story scene by listeners (column 3 lines 61-67 and column 4 lines 1-7), providing concluding narration emphasizing the resolution of the story segment (column 11 lines 9-26), and providing periods when no dialogue or narration occurs to permit a listener to use a pause control on a playback device to pause the playback of the recorded story (column 3 lines 21-26), wherein the sequence of dialogue, narration and periods for pausing the playback promotes discussion between audience members about the story (column 3 lines 48-53).

Re claim 2, Smith III teaches providing study guides and workbooks for review during the audio playback (column 2 lines 61-67).

Re claim 3, Smith III teaches providing the ability for a prospective listener to select one narration category from a plurality of narration categories for playback (column 3 lines 61-67).

Re claim 4, Smith III teaches the periods for pausing is of a duration designed to permit a listener to control the playback device without undue interruption in the audio playback (column 2 lines 15-20 and lines 61-64).

Re claim 7, Smith III teaches repeating the first dialogue segment, first narration segment, second dialogue segment, second narration segment, concluding dialogue

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segment and concluding narration segment for different parts of a story (column 6 lines 51-57).

Re claim 10, Smith III teaches providing dialogue segment between characters in the story, reemphasizing the issue, and telling of consequences of the characters' actions in the story being accompanied by sound effects to promote visualization of a story scene by the listeners (column 10 lines 2-13), and providing a narration segment summarizing the lessons learned from the consequences of the characters' actions in the story after the second narration segment and before the concluding dialogue segment (column 10 lines 51-61).

Re claim 11, Smith III teaches a recording media having recorded thereon data capable of being reproduced as audible sound when played in an audio playback device (column 4 lines 50-67 and column 5 lines 1-7) being in accordance with the following method: providing a first dialogue segment between characters in the story establishing a context for the story being accompanied by sound effects to promote visualization of a story scene by listeners (column 6 lines 44-47), providing a first narration segment articulating an issue being presented in the first dialogue segment (column 7 lines 2-20), providing a second dialogue segment between characters in the story emphasizing the issue being accompanied by sound effects to promote visualization of a story scene by listeners (column 7 lines 31-42), providing a second narration segment identifying the issues that have been presented (column 7 lines 57-67 and column 8 lines 1-3), providing a concluding dialogue segment between characters in the story providing resolution of the story being accompanied by sound effects promoting visualization of

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the story scene by listeners (column 3 lines 61-67 and column 4 lines 1-7), providing concluding narration emphasizing the resolution of the story segment (column 11 lines 9-26), and providing periods when no dialogue or narration occurs to permit a listener to use a pause control on a playback device to pause the playback of the recorded story (column 3 lines 21-26), wherein the sequence of dialogue, narration and periods for pausing the playback promotes discussion between audience members about the story (column 3 lines 48-53).

Re claim 12, Smith III teaches providing written materials for review during the audio playback (column 4 lines 55-57).

Re claim 13, Smith III teaches providing the ability for a prospective listener to select one narration category from a plurality of narration categories for playback (column 7 lines 2-7).

Re claim 14, Smith III teaches the periods for pausing is of a duration designed to permit a listener to control the playback device without undue interruption in the audio playback (column 2 lines 15-20 and lines 61-64).

Re claim 16, Smith III teaches repeating the first dialogue segment, first narration segment, second dialogue segment, second narration segment, concluding dialogue segment and concluding narration segment for different parts of a story (column 6 lines 51-57).

Re claim 19, Smith III teaches providing dialogue segment between characters in the story, reemphasizing the issue, and telling of consequences of the characters' actions in the story, third dialogue segment being accompanied by sound effects to

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promote visualization of a story scene by the listeners (column 10 lines 2-13), and providing narration segment summarizing the lessons learned from the consequences of the characters' actions in the story after the second narration segment and before the concluding dialogue segment (column 10 lines 51-61).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith III 5466158.

Re claim 5, Smith III teaches the invention as discussed above.

However, Smith III does not positively disclose the periods for pausing is four seconds in duration.

It would have been obvious to one of ordinary skill in the art at the time of the invention that since there was no evidence of the criticality of the claimed ranges of periods for pausing and the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235

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Re claim 15, Smith III teaches the invention as discussed above.

However, Smith III does not positively disclose the periods for pausing is three to five seconds in duration.

It would have been obvious to one of ordinary skill in the art at the time of the invention that since there was no evidence of the criticality of the claimed ranges of periods for pausing and the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235

7. Claims 8-9, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith III 5466158 in view of Murata 20020087555.

Re claim 8, Smith III teaches the invention as discussed above. In addition, Smith III teaches reproducing a prologue and transitioning from the prologue to a story with music and sound effects (column 6 lines 42-47).

However, Smith III fails to teach the following limitation as taught by Murata:

Promoting the brand name of the company providing the audio recording
(paragraph 0034-0035)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smith III's invention in view of Murata in order to provide an electronic book data delivery apparatus, an electronic book device and a recording medium that are capable of reading the content of a book aloud in the voices of reciters as taught by Murata (paragraph 0008 lines 2-5).

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Re claim 9, Smith III teaches the invention as discussed above. In addition, Smith III teaches transitioning from the story using music and sound effects and providing an epilogue (column 11 lines 2- 23).

However, Smith III fails to teach the following limitation as taught by Murata:

Promoting the brand name of the company providing the audio recording (paragraph 0034-0035)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smith III's invention in view of Murata in order to provide an electronic book data delivery apparatus, an electronic book device and a recording medium that are capable of reading the content of a book aloud in the voices of reciters as taught by Murata (paragraph 0008 lines2-5).

Re claim 17, Smith III teaches the invention as discussed above. In addition, Smith III teaches reproducing a prologue and transitioning from the prologue to a story with music and sound effects (column 6 lines 42-47).

However, Smith III fails to teach the following limitation as taught by Murata:

Promoting the brand name of the company providing the audio recording (paragraph 0034-0035)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smith III's invention in view of Murata in order to provide an electronic book data delivery apparatus, an electronic book device and a recording medium that are capable of reading the content of a book aloud in the voices of reciters as taught by Murata (paragraph 0008 lines2-5).

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Re claim 18, Smith III teaches the invention as discussed above. In addition, Smith III teaches transitioning from the story using music and sound effects and providing an epilogue (column 11 lines 2- 23).

However, Smith III fails to teach the following limitation as taught by Murata:

Promoting the brand name of the company providing the audio recording
(paragraph 0034-0035)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smith III's invention in view of Murata in order to provide an electronic book data delivery apparatus, an electronic book device and a recording medium that are capable of reading the content of a book aloud in the voices of reciters as taught by Murata (paragraph 0008 lines2-5).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as per the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin L. Carlos whose telephone number is 571-2703077. The examiner can normally be reached on 7:30am-5:00pm EST Mon-Fri (alternate Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



AC

1/15/2008



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